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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/307,195	05/07/1999	WILLIAM COHN	BIH97-04A2	4520

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EXAMINER

SMITH, JEFFREY A

ART UNIT PAPER NUMBER

3625

DATE MAILED: 07/15/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/307,195

Applicant(s)

COHN, WILLIAM

Examiner

Jeffrey A. Smith

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 June 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 37-40 is/are allowed.
- 6) ☒ Claim(s) 1-14, 16-19, 21, 22, 24-36 and 41-50 is/are rejected.
- 7) ☒ Claim(s) 15, 20 and 23 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 May 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 15.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 18 June 2002 has been entered.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1-3, 5-10, 12-14, 16, 18, 19, 22, 24-27, 29-34, 36, 41, 42, and 44-49 are rejected under 35 U.S.C. 102(e) as being anticipated by Benetti et al. (U.S. Patent No. 5,894,843).

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Benetti et al. discloses (Fig. 7) a surgical device (60) comprising a retaining element (62) having an aperture (61); a plurality of suture holders (70); a handle (69); and a tab (63). A method including the steps of positioning, occluding, and connecting are disclosed (col. 12, lines 5-27).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 4, 11, 17, 21, 28, 35, 43, and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Benetti et al. (U.S. Patent No. 5,894,843).

Although Benetti et al. does not disclose irrigation or suction, it would have been obvious to one of ordinary skill in the art to have provided the device reported above to have included such structure because the use of irrigation and suction are well-known for use during surgeries of the type disclosed by Benetti et al.

Double Patenting

Upon further review of the Double Patenting rejection applied in Paper 8 it has been determined that a non-statutory, non-obviousness-type double patenting rejection does not apply in the instant case. Accordingly, such Double Patenting rejection is herein vacated.

Allowable Subject Matter

Claims 15, 20, and 23 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 37-40 are allowed.

Response to Arguments

Applicant's arguments deposited 18 June 2002 have been fully considered but they are not persuasive.

Applicant remarks at page 4 of the Amendment deposited 18 June 2002:

"there is no teaching in Benetti that the artery be compressed between the connector and a surface of the retaining element. There is no description or illustration of the structure shown, for example, in Figure 5 of the present application. There is no surface above the artery in either Figure 1 or Figures 5 and 5A of Benetti. Thus,

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there is no disclosure in Benetti of the two elements operation to compress and occlude the artery between them." (original emphasis).

The Examiner does not find such remarks to be persuasive.

The operative language to which the remarks are directed in claims 1, 25, and 41 merely functionally set forth the features being argued. For example, claim 1 recites: "the connector compresses and occludes the artery against a surface on the retaining element at a first arterial position on a first side of the operative site and at a second arterial position on a second side of the operative site"(emphasis added); claim 25 recites: "artery tissue can be compressed and occluded between the cord and the retaining base and held stationary relative to the retaining base with the cord and the cord retainer"(emphasis added); and claim 41 recites "the cord compresses and occludes a coronary artery positioned between the cord and a portion of the retaining base"(emphasis added).

The functional language recited does not invoke 35 USC 112, 6th paragraph, and the referenced anatomy cannot patentably define structure encompassed by the device or retractors recited.

Moreover, such functional language does not result in a structural difference between the claimed invention and the

prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Additionally, the device (or retractor) disclosed by Benetti is reasonably capable of performing the recited function. Benetti et al. '843 is replete with reference to devices (or retractors) comprising a holder on a retaining element (or base) that holds a connector (i.e. a suture line) that positions the connector to compress the cardiac tissue of the operative site against a retaining element surface. Although Benetti et al. does not expound upon port 70 in their description of the embodiment of Fig. 7, they do refer to such port's utility (i.e. "for receiving a suture line" (col. 12, lines 26-27)). Benetti et al. details the full utility of such suture line receiving port in reference to previous embodiments (see col. 10, lines 57-62; col. 11, lines 19-30; col. 11, line 60-col. 12, line 4). Benetti et al. further teaches that "[i]n some embodiments, as described herein, the contact members 1 may have apertures, openings or attachments to facilitate connection with sutures or other devices to achieve the requisite stabilization" (col. 7, lines 20-24).

The Examiner believes that the entirety of the single Benetti et al. disclosure anticipates Applicant's claims because the disclosure reasonably teaches the full utility of the ports 70 as for receiving a suture line for administering the requisite stabilization of the operative site (e.g. cardiac tissue (col. 11, line 67-col. 12, line 4)) and for depressing the tissue adjacent the target artery (col. 11, lines 27-30).

In specific address of Applicant's remarks that "[t]here is no teaching in Benetti that the artery be compressed between the connector and a surface of the retaining element" (original emphasis), the Examiner notes that Benetti et al. provides an "occluder" 63 at either or both ends of the aperture 61. Benetti et al. discloses that the occluders "[extend] below the surface 62 and [engage] the target artery to substantially reduce or eliminate the flow of blood through the artery" (col. 12, lines 9-12). Having the structure necessary and identically disclosed for providing similarly utility, all that remains is the issue as to whether the Benetti et al. device (or retractor) is reasonably capable of providing the functionality recited by Applicant. The Examiner believes that the compression and occlusion of the target artery by extension of a connector or cord or suture (of the type already disclosed by Benetti et al.) underneath such target artery, thereby compressing and occluding

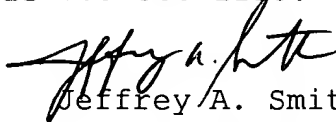
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the target artery against a surface (or portion) of the retaining element (or base) (of the type already disclosed by Benetti et al.) is a functionality readily and reasonably exhibitable by the device (or retractor) of Benetti et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey A. Smith whose telephone number is 703-308-3588. The examiner can normally be reached on M-F 6:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 703-308-1344. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-308-3691 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.


Jeffrey A. Smith
Primary Examiner
Art Unit 3625

jas
July 13, 2002